



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	310048-355	4296

7590

01/02/2003

OPPENHEIMER WOLFF & DONNELLY
38TH FLOOR
2029 CENTURY PARK EAST
LOS ANGELES, CA 900673024

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 01/02/2003

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/158,728

Applicant(s)

WEIRATHER ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Continuation of Disposition of Claims: Claims pending in the application are 282-288,290,293,295-307,309-316,318-320,322-330,332-334,336-342,344,346,347,349-361,363-370,372-374,376-383,385-387 and 389-408.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 282-288,290,293,295-307,309-316,318-320,322-330,332-334,336-342,344,346,347,349-361,363-370,372-374,376-383,385-387 and 389-408.

DETAILED ACTION

1. Applicant's informal response and further reiterated in the interview by Applicant's representative, explains that a facestock sheet is a generic term for the top layer of the sheet of printable material and does not define any particular material. In view of this information the previous restriction requirement is hereby withdrawn and a new restriction requirement based on the interview on December 28, 2002 follows. Furthermore, the time period for response has been restarted.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group	Species	Claims
Facestock Sheet Construction	A. Dry Laminate (dry release-no adhesive next to release liner)	A. 298-301, 352-355, 391, 395, 399, 403, 407
	B. Non-dry Laminate (adhesive release-adhesive next to release liner)	B. 283, 286, 288, 333, 338, 340, 342, 386

Group	Species	Claims
Facestock Sheet Construction Material	C. Glossy Cardstock	C. 293, 347
	D. Tag Sheet	D. 296, 350
	E. Uncoated Tag Sheet	E. 300, 301, 354, 355
	F. Cardstock Sheet	F. 309, 363
	G. Non-tag Facestock	G. 334, 387

Group	Species	Claims
Thin Edge	H. calendaring printable media	H. 325, 326, 346, 378, 379, 394
	I. facestock or liner sheet end edge extends a distance out from the other	I. 313-316, 318-320, 322, 327, 367-379, 372-374, 376, 380, 397, 398, 405, 406

Art Unit: 1772

Group	Species	Claims
Printable Media Arrangement	J. single piece	J. 400, 408
	K. matrix	K. 287, 290, 302, 329, 330, 336, 344, 382, 383, 389, 393, 402

Note: A complete response to the restriction requirement requires a species election from each of the groups above. Furthermore, Applicant is advised that some claims have more than one group and species in it, i.e. a claim contains two different species from two different groups. If all the species from a particular claim are not chosen as the elected species the claim will be considered non-elected.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claims 282 and 337 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a *listing of all claims readable thereon, including any claims subsequently added*. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

Art Unit: 1772

species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Due to the complexity of the species election/restriction a telephone call was not made to request an oral election to the above restriction requirement

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant's representative is more the welcome to call either the Examiner or her SPE to schedule an interview. The phone numbers for the Examiner and her SPE are provided below. However, Applicant's representative is advised any interview conducted before a first action on it's merits of the claims will not include a discussion of prior art, since no art has been applied to the claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139.

Application/Control Number: 09/158,728

Page 5

Art Unit: 1772

The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

12/30/02




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/30/02